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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,783	08/25/2003	LeRoy Thomas Warren JR.	07890009AA	1103

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EXAMINER	
PIERCE, WILLIAM M	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/646,783	WARREN ET AL.	
	Examiner	Art Unit	
	William M. Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 20 May 2005.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed as set forth in the previous office action and below in response to applicant's remarks.

Claims 1-25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as set forth in the previous office action and below in response to applicant's remarks.

Claims 1-223 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, slip resistant is indefinite since it is a relative term with no given means for comparison. One cannot determine the metes and bounds of something that is slip resistant. Claims 10-12 are indefinite and fail to further limit the structure of the previously recited elements. 35 USC 112 requires that a dependent claim further limit the structure of a previously recited element. Claims 10-12 contain only functional and narrative recitation and do not further limit a preiously recited element. In claim 23, "the entire circumference" lacks a proper antecedent.

Claim Rejections - 35 USC § 102

Claims 1, 2, 4-19 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lanzetta 6,368,228 as set forth in the previous office action and below in response to applicant's remarks.

As to claim 1, 6, 7, 8-16,18 and 19, '228 shows a belt 11A, rail covers 18 and tapered thimbles 17. He further shows that using a "frictional surface covering, such as rubber tubing, which aids in the elevation of the balls" (col., 1, ln. 20) is desirable. As to claim 2, the use of neoprene in belts such as that in '228 is considered well known and inherent. As to claims 4 and 4, 228 shows upper and lower track rail covers 17 and 19 respectively. As to claim 17 the bars of 16 of '228 are considered to be the inner core and the covers 18 are of a "softer" rubber urethane material. As to claim 23, 19w is considered part of the thimble and is consider to extend about the entire circumference. As to claim 24, the outermost end of the track of Lanzetta is considered to be at 18, as such his thimble 17 is considered to extend past the outermost end as called for by the claim. As to claim 25, Lanzetta's fig. 1 is considered to show his thimble fitting "over" an outer most end. Albeit his thimble may be considered to be mounted to the side of the rail, its mounting point is considered to be an outermost end that is covered which meets the limitations of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '228 in view of matters old and well known to the art and design of machine elements as shown by Flototto 3,690,743 as set forth in the previous office action and below in response to applicant's remarks.

As to claims 3, 20 and 21, '228 shows the tensioning bracket in fig 1 but does not discuss it in any detail. Note that this bracket is shown by element 80 in Ernst 3,297,322 as being a part familiar to one of ordinary skill in the art. The use of slots instead of holes in machine elements are well known when adjustment is necessary. To have change the holes in the bracket o'228 to slots would have been obvious to one of ordinary skill in the art in order to make the mounting of the bracket easier to adjust and align. Flototto is one teaching of the expedient of replacing slots for holes to allow for a "stepless adjustment" (col. 7, ln. 50). As to claim 22 the thimbles of '228 are considered adjustable

Response to Arguments

Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive. ***.

Applicant's at the bottom of pg. 6 traverse the best mode rejection stating that the best mode requirement "does not require every specific working example" and that the applicant's have "presented one embodiment ...with additional examples." Examiner disagrees that a specific example and giving one embodiment satisfies best mode requirement. Held is that the best mode requirement is a safeguard against the desire on the part of some people to obtain patent protection without making a full disclosure as required by the statute. The requirement does not permit inventors to disclose only what they know to be their second-best embodiment, while retaining the best for themselves. In re Nelson, 280 F.2d 172, 126 USPQ 242 (CCPA 1960). As is the instant situation, applicant has presented his "second-best mode" as being only neoprene rubber (pg. .9, ln. 14 of spec.) and retains his best mode for himself as being "specially formulated urethane material manufactured by a proprietary method" (pg. 9, ln. 4 of spec.).

In re Gay does not apply to the facts at hand. The examiner has not applied the best mode rejection for lack of a specific example.

With respect to 2165.03, applicant has omitted the sections that are unfavorable to his argument. Ignored by applicant from 2165.03 is that the examiner must determine whether the inventor knew that one mode was better than another, and if so whether the disclosure is adequate to enable one of ordinary skill in the art to practice the best mode. According to the approach used by the court in Chemcast Corp. v. Arco Industries, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990), a proper best mode analysis has two components: (A) Determine whether, at the time the application was filed, the inventor knew of a mode of practicing the claimed invention that the inventor considered to be better than any other. It is clear from the inventors specification and his own admitions that the inventor knew of a mode of practicing the invention that is better. On pg. 9 of his specification he clearly discloses that neoprene is substandare the "specially formulated urethane" because the urethane has better fricitional properties. He even goes on to say that the lower portion of the track rails must be covered with the specially formulated urethane there "slipping problems are the most critical" (pg. 9, ln. 18) "where the yo-yo effect can occur". Clearly from his own specification the specially formulated urethane is better than any other mode since it is less likely to present slipping problems. Evidence that the inventors had information in their possession is from his own addmitions in the specification that "specially formulaed urethane material manufactured by a proprietary method" (pg. 9, ln. 4)
The second component is to ask whether the disclosure isadequate to enable one skilled in the art to practice the best mode. Obviously, the answer is no. One skilled in the art would not know how to make the "specially formulated urethane material having the frictional properties to prevent slipping since applicant is keeping its making "proprietary".

Applicant argues that he has disclosed "neoprene rubber" as also being used for covers of the rails. However he only discloses neoprene rubber to be used in a "multi-piece construction" (pg. 9, ln. 20) on the upper portion of the rails where slipping is less of a problem. He does not disclose where the entire rail cover can be of neoprene. From his specification, the lower portion of the rails cover must be the speicially formulated urethane .

At the top of pg. 8, applicant argues that other types of materials that can provide similar frictional characteristics should also be considered. However, applicant has not disclosed what are the "frictional characteristics" of "the urethane material" (pg. 10, ln. 15). To say that "any material" similar to the properties of urethane are acceptable does not meet the applicant's duty to set forth the best mode.

As set forth above, the evidence of concealment is that neoprene can only be used on the upper portion of the rails when a multi-piece construction is used. From the specification, the specially formulated urethane must be

used on the lower portion of the rails when friction is critical to prevent slippage (pg. 9, ln. 17). As stated above, the neoprene is disclosed as the "second-best" material and the "best" is the specially formulated urethame material which applicant fails to disclose. At the top of pg. 9 of his remarks he states that the "specially formulated material is only one material that can be used". This statement is made without support from the specification. The specification states that the specially formulated material (or one having similar frictional properties) must be used. The use of neoprene is only in a multi-piece construction in combination with the urethane that must be used on the lower portion of the rails. Further more, any mention of other materials in the specification is that they are substandard to the specially formulated urethane in that they lack the frictional properties to prevent the "yo-yo" effect on the bottom portion of the rails.

In conclusion, the purpose of the best mode requirement is to "restrain inventors from applying for patents while at the same time concealing from the public the preferred embodiments of their inventions which they have in fact conceived," In re Gay, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962). Here, in the instant situation applicant is applying for a patent while wishing to keep secret the best material to use on rails. Other materials disclosed in applicant's specification have insufficient frictional properties to be used on the lower portions of the rails and will not work by his own admissions. As such a best mode rejection is deemed proper to prevent applicant from obtaining a patent while concealing from the public what he has in fact conceived.

At the bottom of pg. 9, applicant sets forth the standard for determining enablement to be "whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation". From the applicant's specification he discloses most broadly covering the rails of a material having frictional property to prevent "slipping" or "yo-yo" (pg. 9, ln. 17) in the lower portion of the rails. His specification states that neoprene, while less expensive, is insufficient for the lower portion of the rails and that a "specially formulated urethane material" must be used. Hence it follows that one skilled in the art must experiment with any and all "formulations" of urethane to find one that prevents slipping. This is considered undue experimentation since such experimentation is only required by applicant's desire to keep the material "proprietary". One skilled in the art would be unduly burdened by having to try to experiment with all of the possible formulations of urethanes that are known in the art.

Examiner submits that materials held as "proprietary" cannot be considered "commonly known materials". True applicant states the "other material" that provide similar properties to the urethane are acceptable. However, he does not state in the specification what those material properties are so that one skilled in the art would be capable of selecting another equivalent material. One skilled in that art not knowing the physical properties of the "specially

formulated urethane" material could not make and or use applicant's invention since he could not determine suitable equivalents since the nature of such is being held by applicant as "proprietary".

As stated above, one skilled in the art could not practice the invention using neoprene since such is disclosed as only being used in the two piece cover design (pg. 9, ln. 14). The bottom of the rails require "the formulated urethane" since it has "better friction properties than neoprene rubber" (pg. 9, ln. 15). As such, since the use of the "formulated urethane" is required to practice the invention and the application has not disclosed what this material is, the specification is considered non-enabling.

Accoridingly, applicants have admitted that they are keeping the type of material used to cover the rails a secret. Neoprene alone cannot be used since it does not have the frictional properties of the "formulated urethane" (pg. 9, ln. 16). To use neoprence, the "formulated urethane" must be used on the lower portions of the rails where slipping problems are the most critical. As such applicant's specification leaves one skilled in that art without adequate information as to the properties of the material that would prevent slipping in the lower portions of the rails. One would be faced with experimenting with any and all formulations of urethanes which would be considered undue.

At the top of pg. 11, applicant mentions "objective truth". However, such a remark is considered misplaced since examiner never challenged the truthfulness of the specification. Applicant's may in fact have a "specially formulated urethane" or have yet to find a suitable urethane material. In any case, the type of urethane that will work to address the slipping problems on the rails must be disclosed for the disclosure to be enabling.

With respect to the 35 USC112 rejection for lack of providing adequate structural relationships, the examiner has not sustained this grounds for rejection as that when viewed in light of the specification such relationships are considered adequate. The remaining rejections under 112 are set forth above in the grounds for rejection.

As to the rejection of claim 1 under Lanzetta, applicant merely maintains that the lower section 17 is "not a thimble. However, claims 1 and 6 calls for "tapered timbles...fitted to a lower portion of the track rails". Nothing in the claims requires to "cover the end of the rail" as stated by applicant in the middle of pg. 15 of his remarks. Nothing more than descriptive is being read into the word thimble.

Applicant's arguments with respect to claims 6-12 amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Once again merely reciting "thimble" without any further limiting structure does not distinguish over the applied art. Limitations will not be read into the claims that are not there.

Examiner's position with respect to claim 13 and his interpretation of the "thimbles" shown by Lanzetta is set forth above. Further, he is considered to show a "gripper kit" in the addition of his elements C to the rails of a ball lift.

Fig. 1 of Lanzetta shows what can be considered a tensioning bracket between the pulleys comprising a spring between telescoping sections. To best illustrate examiners interpretation of Lanzetta, element 54 of Ernst shows the adjustable bracket of ball lift mechanisms of the type shown by Lanzetta in his fig. 1. Applicant's position that a tensioning bracket is not shown is not persuasive.

Applicant's arguments with respect to claims 14 and 16-19 amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references and as such are not persuasive.

As to the rejection under Lanzetta in view of Flototto as applied to claim 20, a bracket between the pulleys comprising a spring between telescoping sections as shown in his fig. 1 is considered shown. Lanzetta shows a solid bracket that is acknowledged. However, providing slots instead of holes to allow an adjustment instead of exact position is a known expedient as taught by Flototto. In order to determine analogous art, one must determine the problem facing the inventor at the time of the invention. The problem was how to make a rigid bracket adjustable which can come from any art. As such the teachings of Flototto would have been clearly applicable for suggesting using slots to allow for a "stepless adjustment" (col. 7, ln. 50).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703)

872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

WILLIAM M. PIERCE
PRIMARY EXAMINER